

REMARKS

A. POTENTIAL ALLOWABILITY OF CLAIMS 3, 8, 61 and 62

The Examiner's comments regarding the potential allowability of claims 3, 8, 61 and 62 are gratefully acknowledged. However, in view of the remarks made herein below, an amendment to render claims 3, 8, 61 and 62 independent is not deemed necessary at this time.

B. REJECTION OF CLAIMS 1, 6, 52, 53 AND 59 UNDER 35 U.S.C. 103

On page 2 of the Office Action, the Examiner has rejected claims 1, 6, 52, 53 and 56-59 under 35 U.S.C. 103(a) as being unpatentable over Petrunka *et al.*, U.S. Patent 5,991,369 (hereinafter referred to as Petrunka) in view of Kasiviswanathan U.S. Patent 6,215,857 (hereinafter referred to as Kasiviswanathan). Applicant respectfully disagrees.

As set forth herein below, one skilled in the art would not reasonably expect that Kasiviswanathan could be successfully incorporated into Petrunka to arrive at the claimed invention.

Claim 1

Since the Examiner has only broadly referred to Figure 4 of Petrunka without citing any specific passages of the specification, one must begin by having a closer look at Petrunka in order to identify what elements/features of Petrunka the Examiner may have thought are candidates for the claimed feature of "a call setup message". To begin this analysis, one observes that a first feature of the claimed call setup message is that it "initiat[es] the establishment of a call connection directly to the VMS". A

second feature of the claimed call setup message is that it is “issu[ed ...] into a common channel signaling (CCS) network”.

Based on the above criteria, there are only two elements/features of Petrunka that the Examiner may possibly have considered to be candidates for the claimed “call setup message”, and both are forms of messages emanating from the “services computer 36” of Petrunka. Specifically:

Case I - column 4, lines 31-33 and 37-39: “Services computer 36 then gains access to the voice mail system 39 by providing system 39 with any necessary access information, such as a password (step 442) [...] After accessing voice mail system 39, services computer 36 then provides system 39 with the necessary codes to leave a message in a voice mail box (step 444)”; and

Case II - column 4, lines 42-45: “Services computer 36 then instructs Operator Services Switch 32 to connect caller 30 to the accessed voice mail box (step 446).”

There is also a third feature of the claimed call setup message, namely that it has “a format reserved for a redirected call set-up message issued by a service switching point (SSP) in response to an uncompleted call to the service subscriber”. Having admitted that this third feature is not explicitly stated in Petrunka (Office Action, page 2), the Examiner has referred to “column 5” of Kasiviswanathan in an attempt to bring to light the purported existence of this feature in the prior art. With respect, Applicant believes this reliance upon Kasiviswanathan to be flawed.

To better understand Applicant’s position, one must examine in greater detail what column 5 of Kasiviswanathan actually teaches. One will observe from a representative passage of column 5 (namely, lines 42-45) that, according to Kasiviswanathan, “Switch A sends a ‘Service Activation Parameter’ with a ‘Feature Code’ coded as a ‘DVMA request’ in the Initial Address Message (IAM), along with other information, to Switch B (step 525)”.

Now, firstly, neither the aforesaid IAM, nor any other message disclosed by Kasiviswanathan, is mentioned as having the claimed format, namely one that is “reserved for a redirected call set-up message issued by a service switching point (SSP) in response to an uncompleted call to the service subscriber.” On this basis alone, Applicant believes that Kasiviswanathan is just as defective as Petrunka in teaching at least one of the claimed limitations. As such, Applicant believes to have demonstrated that the Examiner has failed to establish a *prima facie* case of obviousness, on at least the ground that there is at least one claimed limitation that is not taught anywhere in the prior art¹.

Notwithstanding the above, even if Kasiviswanathan’s IAM were hypothetically² interpreted as “having a format reserved for a redirected call set-up message issued by a service switching point (SSP) in response to an uncompleted call to the service subscriber”, the use of such a message format would be utterly ineffective in bringing the system of Petrunka closer to the claimed invention.

Consider Case I – above, where Petrunka contemplates gaining access to the voice mail system by providing the latter with administrative information such as access information, codes, etc. This clearly cannot be achieved by using a message which has a format reserved for a redirected call setup message issued by a service switching point (SSP) in response to an uncompleted call to the service subscriber, because such a format does not accommodate the specific administrative information required by Petrunka.

Consider also Case II – above, where Petrunka contemplates instructing the, “Operator Services Switch” to connect the caller to the accessed voice mail box. This is in fact a switching instruction, which bears no relation whatsoever to a message having a

¹ For the Examiner to establish a *prima facie* case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.).

² Without acquiescing in this interpretation

format reserved for a redirected call setup message issued by a service switching point (SSP) in response to an uncompleted call to the service subscriber.

Based on the foregoing, one is compelled to conclude that there is no reasonable expectation of success in trying to use the teachings of Kasiviswanathan to remedy the deficiencies of Petrunka in order to arrive at the claimed invention. As such, it is respectfully suggested that the Examiner has failed to establish a *prima facie* case of obviousness, on at least the ground that there is not a reasonable expectation of success.

By way of additional explanation, is respectfully submitted that Petrunka's failure to successfully incorporate the teachings of Kasiviswanathan to arrive at the present invention should not be surprising, given that all messages related to call forwarding activities in both Petrunka and Kasiviswanathan are produced after the call has already entered the PSTN. In contrast, the present invention claims that a message having a certain type of reserved format be formulated before the establishment of a call connection is even initiated.

Finally, upon further analysis of the prior art references, there actually seems to be no effect, let alone a desirable one, of combining Petrunka's system with that of Kasiviswanathan. For instance, Applicant doubts that a person skilled in the art and taught by Petrunka would be interested in Kasiviswanathan's forwarding solution (executed at the called party's terminating switch), since Petrunka doesn't even allow the call to get to the called party's terminating switch. Hence, Applicant believes to have effectively challenged and overridden the Examiner's alleged motivation to combine the references (which was to "improve the system's flexibility by utilizing AIN technology"), by showing that Petrunka and Kasiviswanathan are in some sense orthogonal to one another. As such, it is respectfully suggested that the Examiner has failed to establish a *prima facie* case of obviousness, on at least the ground that there is no motivation to combine the prior art references.

In view of the above, it is believed that claim 1 is in condition for allowance and the Examiner is respectfully requested to withdraw the rejection of claim 1.

Claims 6 and 52

These claims include language similar to that of claim 1 and therefore the Examiner is referred to the above arguments in support of claim 1. As such, it is believed that claims 6 and 52 are in condition for allowance and the Examiner is respectfully requested to withdraw the rejection of claims 6 and 52.

Claims 53 and 56-59

These claims are all dependent on claim 52 which, as stated above, is believed to be in condition for allowance. As such, the Examiner is respectfully requested to withdraw the rejection of claims 53 and 56-59

C. REJECTION OF CLAIMS 2, 4, 7 AND 60 UNDER 35 U.S.C. 103

On page 6 of the Office Action, the Examiner has rejected claims 2, 4, 7 and 60 under 35 U.S.C. 103(a) as being unpatentable over Petrunka combined with Kasiviswanathan in further view of Applicant's Admitted Prior Art. Applicant respectfully disagrees.

As set forth herein above, one skilled in the art would not reasonably expect that Kasiviswanathan could be successfully incorporated into Petrunka to arrive at the claimed invention. In addition, it is respectfully submitted that there is nothing in the instant application to suggest otherwise. Moreover, since claims 2, 4, 7 and 60 are all dependent on at least one claim that has been argued as being allowable, it is believed that claims 2, 4, 6 and 60 are also in condition for allowance and the Examiner is respectfully requested to withdraw the rejection of claims 2, 4, 7 and 60.

D. REJECTION OF CLAIM 54 UNDER 35 U.S.C. 103

On page 8 of the Office Action, the Examiner has rejected claim 54 under 35 U.S.C. 103(a) as being unpatentable over Petrunka combined with Kasiviswanathan in further view of Tov *et al.*, U.S. Patent Application Publication No. 2002/0152402 (hereinafter referred to as Tov).

As set forth herein above, one skilled in the art would not reasonably expect that Kasiviswanathan could be successfully incorporated into Petrunka to arrive at the claimed invention. In addition, it is respectfully submitted that there is nothing in Tov to suggest otherwise, as Tov merely teaches a method to allow Internet service subscribers to expose a person-specific personalization to their "visitor Web pages". Moreover, since claim 54 is dependent on a claim that has been argued as being allowable, it is believed that claim 54 is also in condition for allowance and the Examiner is respectfully requested to withdraw the rejection of claim 54.

E. REJECTION OF CLAIM 5 UNDER 35 U.S.C. 103

On page 8 of the Office Action, the Examiner has rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Petrunka combined with Kasiviswanathan in further view of Russell, Travis, *Signaling System #7* (hereinafter referred to as Russell).

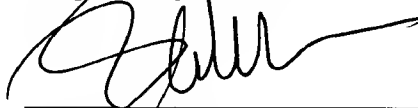
As set forth herein above, one skilled in the art would not reasonably expect that Kasiviswanathan could be successfully incorporated into Petrunka to arrive at the claimed invention. In addition, it is respectfully submitted that there is nothing in Russell to suggest otherwise, as Russell deals with merely with the SS7 protocol. Moreover, since claim 5 is dependent on a claim that has been argued as being allowable, it is believed that claim 5 is also in condition for allowance and the Examiner is respectfully requested to withdraw the rejection of claim 5.

CONCLUSION

In view of the foregoing, Applicant is of the view that claims 1-62 are in allowable form. Favourable reconsideration is requested. Early allowance of the Application is earnestly solicited.

If the application is not considered to be in full condition for allowance, for any reason, the Applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,



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